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UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/117,214 07/24/98 SERVANTE

A 292/30.35.37

| EXAMINER |
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IM22/0103

PRATT, C

| ART UNIT | PAPER NUMBER |
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WENDEROTH LIND & PONACK
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WASHINGTON DC 20006

1771

5
01/03/00

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|------------------------|---------------------|
| | 09/117,214 | SERVANTE ET AL. |
| Examiner | Art Unit | |
| Christopher C. Pratt | 1771 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

1) Responsive to communication(s) filed on 24 July 1998 .

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-15 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some * c) None of the CERTIFIED copies of the priority documents have been:

1. received.

2. received in Application No. (Series Code / Serial Number) 09/117,214.

3. received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

14) Notice of References Cited (PTO-892) 17) Interview Summary (PTO-413) Paper No(s). _____
15) Notice of Draftsperson's Patent Drawing Review (PTO-948) 18) Notice of Informal Patent Application (PTO-152)
16) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 19) Other: _____

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DETAILED ACTION

Claim Objections

Claims 2-6, 8, and 11 objected to because of the following informalities:

Characterized should be replaced with comprising or wherein. Appropriate correction is required.

Claims 1-2 and 12 contain the words "polymerisation" and "fibre." The spelling of these words should be changed to polymerization and fiber.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 12 recite the limitation "a reasonably open surface." It is unclear what applicant intends by "open surface." Is applicant claiming a cellular structure?

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as

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to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 15 recites the broad recitation "a container", and the claim also recites "a bottle" which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 6-15 rejected under 35 U.S.C. 102(b) as being anticipated by Kaburaki (5047286).

Kaburaki's patent is concerned with the creation of a printing sheet material with improved printability. Kaburaki discloses the use of substrate covered on one side by a surface layer (abstract). Kaburaki also discloses said surface layer to consist

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essentially of a 1-70% by weight of a water-dispersible polymer and 30-100% of an ethylenically unsaturated compound (col. 2-3, lines 60-30).

With respect to claims 2-3, Kaburaki discloses substrates covering applicants claim (col. 4, lines 30-35).

With respect to claim 4, Kaburaki discloses water dispersible polymers covering applicants claim (col. 3, lines 5-26).

With respect to claim 6 and 10, Kaburaki discloses a crosslinking agent in an amount of from .05 to 10% (col. 4, lines 50-67).

With respect to claim 7 and 11, Kaburaki discloses a primer layer (col. 3, line 63).

With respect to claim 8, Kaburaki discloses an adhesive layer (col. 5, line 24).

With respect to claim 9, Kaburaki discloses a process of coating one side of said substrate and drying said coating (col. 3-4, lines 65-2).

With respect to claim 12 and 13, Kaburaki discloses all elements of subheadings "a" and "b" of claim 12, as stated in the above rejections. Kaburaki further discloses the steps of inking and curing the dried coating with a UV-curable ink (col. 3, lines 53-55).

With respect to claim 14, Kaburaki discloses the use of an adhesive and release layer as well as an intended use as a label.

With respect to claim 15, the intended use does not seem to effect the patentable characteristics of the claimed article therefore this claims bears no patentable weight.

Claim Rejections - 35 USC § 103

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Kaburaki (5047286) in view of Atherton (5714245).

Kaburaki's patent is concerned with the creation of a printing sheet material with improved printability. Kaburaki discloses all elements of applicant's claim 1 to which claim 5 refers. Kaburaki fails to teach the use of urethane.

Atherton's patent is concerned with the creation of an ink-receiving sheet. Atherton teaches the use of urethane as a water dispersable polymer (col. 3, line 3). It would have been obvious to a person of ordinary skill in the art to combine the printing sheet of Kaburaki with the urethane taught by Atherton. Such a combination would have been motivated by the reasoned expectation of combining the printing sheet with improved printability of Kaburaki with the ink receptive coating taught by Atherton.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Audett (5585416), Anderson (5700623), and Farrar (4592953) all seem to disclose elements of applicants invention.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Pratt whose telephone number is 703-305-6559. The examiner can normally be reached on Monday - Friday from 7 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-308-2351 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2351.

Christopher C. Pratt
December 20, 1999


BLAINE COOPENHEAVER
PRIMARY EXAMINER